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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,495	07/11/2003	Christian John Lee	C-389 DIV	3998

7590 12/14/2004  
Sidney Persley, Esq.  
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222 Bridge Plaza South  
Fort Lee, NJ 07024

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/617,495

Applicant(s)

LEE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers filed on 15 October 2004.

I. In the "REMARKS" section on page 6, a signature is missing. A proper correction to fulfill to record is requested and required in practice before the Office. Otherwise it would have no value. It is assumed that (1) it is a mistake and (2) a proper correction will be made. Accordingly, the "REMARKS" is provisionally considered only.

II. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al (5,372,635).

Wasilewski et al disclose, teach and suggest a lithographic printing ink composition and its use in a printing process. The composition comprises glycerol (glycerine) on col.3:7, a nonionic surfactant having a hydrophilic/lipophilic balance of from 11-20 on col.3:16-17 and (water ( $H+OH$  or  $H_2O$ ) formed in situ in a process of making a soap ( $ROOK$ ). A fatty acid ( $RCOOH$ ) and an alkaline agent ( $KOH$ ) are reacted to give the product mixture of soap ( $RCOOK$ ) and water ( $H_2O$ ) as conventional and well known in the art. Applicants are should show or provide an evidence to the contrary) on col.2:59 to 3:3 and Examples. Since Wasilewski et al disclose, teach and suggest the presence of water in printing ink compositions in a process of a soap forming situ, the presence of water would result in an aqueous dampening property as claimed and urged in the absence of an evidence to the contrary for the patentability of the claim.

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Applicant's arguments filed 15 October 2004 have been fully considered but they are not persuasive.

Applicants urge that the claim does not cite an additional aqueous dampening process. The arguments have a little value and are not found to be convincing since the language "method...printing comprising" is open to any additional process.

Applicants urge that "self-dampening" means an avoiding of a dampening step. The arguments have a little value and are not found to be convincing since there is no evidence that a dampening step would cause a deleterious printing process or result in order for the argument to have some merits or values for the patentability of the claim. It is, however, found that the use a single self-dampening composition would result in no need for the use of a dampening step only.

Applicants urge that an amount of water formed in situ is small. The arguments have a little value and are not found to be convincing since the claim is has not limited to a large amount of water but is open to any amount of water as broadly claimed.

It would like to see an aqueous dampening property tested result with the use of a small amount of water in the printing compositions in the applied Wasilewski et al for the arguments with respect to the property of water in the printing composition and its use in a printing process as urge.

III. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blair (GB 1 336 356).

Blair discloses, teaches and suggests a lithographic printing ink composition and its use in a printing process. The composition comprising glycerol (glycerine), a nonionic surfactant

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having a hydrophilic/libophilic balance of from 12 and up close to about 5% of water. Please see the whole disclosure of the applied reference, especially at page 2:39-40, 63-66; 5:106 and 116-117; 6:26-29, 7:45-50; 8:41-44. Since Blair discloses, teaches and suggests the presence of up close to about 5% of water in printing ink compositions, the presence of water would result in an aqueous dampening property as claimed and urged in the absence of an evidence to the contrary for the patentability of the claim.

Applicant's arguments filed 15 October 2004 have been fully considered but they are not persuasive.

Applicants recognize that Blair printing ink processes using printing ink compositions comprising up close to about 5 wt% of water.

Applicants fail to recognize that water is in a mixture with a nonionic surfactant. Please see at least.

Applicants urge that Blair printing ink compositions contain polyhydric alcohol. The arguments have a little value and are not found to be convincing since the language "composition comprising" is not excluded any chemical ingredient but is open to include a chemical ingredient including polyhydric alcohol.

Applicants urge that the claim contain glycerol. Applicants fail to recognize that Blair discloses, teach and suggest the use of glycerol (glycerine) in a printing ink composition and its use in a printing process. Please see at least at page 5, line 106.

The same chemical in the same chemical composition or about the same composition would provide a the same or about the same property.

It would like see an aqueous dampening property test result with the use of up close to 5 wt% of water in the printing ink compositions in the applied Blair for the property of water in a printing composition and its use in a printing process.

The instant claim has not been limited to the use of from 20 to 50 wt% of water as cited in paragraph [0018] of the instant application. It has a little value as broadly claimed.

It would like see a stabilizing property test result with the use of glycerine in the printing ink compositions in the applied Blair for the property of glycerine in a printing composition and its use in a printing process.

For the arguments with respect to a property of a material, please see the authority as stated in *In re Schreiber*, 44 USPQ2d 1429 states that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*...169 USPQ 226, 228...Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state...where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." A statement or argument alone may have and be given a little to no value because it is not factual evidence.

IV. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kelly Cynthia can be reached on 571-272-1526

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
09 December 2004

HOA VAN LE  
PRIMARY EXAMINER

*Hoa Van Le*